Remarks In Response to the Office Action

General Remarks

Claims 1-4, 6, 8-10, 12-19, 21, 23-25, 27-34, 36, 38-40, and 42-45 are pending. No claims have been added, cancelled, or amended with this Reply.

Claim Rejections - 35 USC § 103

In responding to the Examiner's prior art rejections, Assignee here only justifies the patentability of the independent claims (*i.e.,* claims 1, 16, and 31). As the Examiner will appreciate, should these independent claims be patentable over the prior art, the dependent claims would also necessarily be patentable. Accordingly, Assignee does not separately discuss the patentability of the dependent claims, although Assignee reserves the right to do so at a later time if necessary.

Independent claims 1, 16, and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fangzhe Chang & Vijay Karamcheti "Automatic Configuration and Run-Tim Adaptation of Distributed Applications" (hereinafter Chang) in view of US 5,884,311 ("Blattmann").

A. The Rejection Fails to Present a Prima Facie Case of Obviousness

1) The Obviousness Rejection Simply Reiterates Previous Section 102 Rejections and Cites Discrete Portions of a Secondary Reference

First, the present rejection fails to present a *prima facie* case of obviousness because it merely reiterates previous arguments presented against the claims in Second 102 Rejections and cities to discrete portions of a secondary reference for obviousness. Prosecution of the present application has been reopened after the filing of an appeal. In previous Office Actions, all pending claims in the application were rejected under 35 U.S.C. 102(a) as being anticipated by Chang. *See e.g.,* Final Office Action mailed 08/09/07. Now that prosecution has been reopened, "[t]he Examiner still contends that the functionality of the claimed limitations is performed fully by Chang et

al. with respect to a server and its resources." Yet, "the Examiner has opted to provide an obviousness teaching of database being configured and modified according to performance utilization monitored as introduced by the secondary reference Blattmann-Bleile et al." Present Office Action at pg. 7. In fact, the Examiner's arguments in the present Office Action are simply the same arguments that were presented previously and required reopening of prosecution after Assignee appealed the rejections to the Board. In the present rejection, however, the Examiner has merely cited to the Abstract and two lines of text in the secondary reference of Blattmann to present an obviousness rejection of Assignee's claims. Simply reiterating the same argument and merely citing to discrete portions of Blattmann indicates that the present obviousness rejection utterly fails on its face to present a *prima facie* case of obviousness against the claims.

2) No Objective Reason Exists for Combining the Reference

Second, the present rejection fails to present a *prima facie* case of obviousness because it offers no objective reasons for combining Chang and Blattmann. In fact, no such reasons exist. In the Office Action, the Examiner appears to contend that using the functionality of a distributed application executing on a server (as taught in Chang) to a database and database objects would be obvious "because servers can include database[s] and can be themselves considered an organized structure body of data used for storage and retrieval as prevalent in the art." Present Office Action at pg. 4. This contention appears to be merely conclusory and fails to meet any of the basic requirements of a prima facie case of obviousness because it fails to clearly articulate the reasons why the claimed invention would have been obvious and is merely conclusory.

As is well established, "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). In fact, "[t]he Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness.'" MPEP 2142 *citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). The fact that the Examiner gives no objective reasons to combine these teachings and instead simply concludes that one skilled in the art would modify Change's teaching to include database and database objects (Present Office Action at pg. 4) further indicates that the rejection fails to establish a *prima facie* case of obviousness.

3) There is No Motivation to Combine Chang and Blattmann

Third, the present rejection fails to present a *prima facie* case of obviousness because there is no motivation to combine Chang in view of Blattmann. As is well established, "[o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so" MPEP 2143.01 *citing In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching test as a guard against using hindsight in an obviousness analysis). Chang is directed to configuring a distributed application, while Blattmann is directed to configuring a relational database. Chang and Blattmann make no such suggestion of being combined. This indicates that there is no motivation to combine these references and that the proposed combination is improper.

In addition, no discussion is provided about how the Examiner's proposed combination would produce predicable results to one of ordinary skill in the art. *See* MPEP 2143.01 *citing KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). This further indicates that there is no motivation to combine these references and that the proposed combination is improper.

In light of the above, the Office Action fails to establish a *prima facie* case of obviousness, and all pending claims in the application are believed to be allowable for at least this reason alone.

B. Chang in view of Blattmann Still Fails to Render the Claims Obvious Even If Combinable

Despite the fact that Chang in view of Blattmann fails to establish a *prima facie* case of obviousness, Assignee addresses the merits of the rejection to show that Chang in view of Blattmann even if combinable still fails to render the claims obvious.

Assignee has discussed the numerous differences between Chang and Assignee's claims extensively in previous responses. *See e.g.,* Response to Office Action filed 05/22/07 & Appeal Brief filed 01/08/08. Chang is directed to a distributed application and its configuration, whereas Assignee's claims are directed to a database having database objects and to management of the database. As discussed before, Chang teaches how to tune the configuration of a distributed application executing on a distributed platform (pg. 11 (¶ 5)) and merely describes his framework using a client-server application (pg. 12 (¶ 5-7). Chang is clearly directed to a "distributed application" and discusses a tunability interface to tune such a distributed application and a virtual execution environment to emulate run-time availability of resources on a static distributed environment. *See* Chang at pg. 11 (¶ 5).

Despite the fundamental and numerous differences between Change and Assignee's claims, the Examiner maintains the rejection by inappropriately interpreting particular portions of Chang's disclosure against elements of Assignee's claims. For example, the Examiner flatly assert that a "server (as taught by Chang et al.) can be interpreted by a person of ordinary skill in the art to read on a database" (presumably as claimed) and that "server resource modules (as taught by Chang et al.) can be interpreted by a person of ordinary skill in the art to read on a database objects" (presumably as claimed). *See* Office Action at pg. 7. These mere assertions are made without any form of support whatsoever. Instead, the Examiner merely equates servers and databases "because servers can include database[s] and can be themselves considered an organized structure body of data used for storage and retrieval as prevalent in the art." Office Action at pg. 4. Assignee's claim language and the context of Assignee's claims, however, must be given more consideration than the rejection's sweeping and unsupported assertions that Assignee's claimed elements read on

Chang's teachings because Chang's teachings can be interpreted in a conclusory way to be the elements of Assignee's claims. Instead, the language of Assignee's claims must be given their plain meaning and must be interpreted consistent with the specification and with the interpretation of those skilled in the art. *See* MPEP 2111.

In fact, the Examiner has previously stated that the "Examiner is broadly interpreting the recitation of 'server' application storing large images in Change et al. page 12, ¶ 5, [to] be 'database' and 'the large images'…to be 'database objects.'" (Final Office Action at page 5). This statement shows that the Examiner is improperly reading subject matter into the disclosure of Change et al. that is not actually disclosed or even suggested in Change et al. Change et al. does not suggest that the client-server application (referred to as active visualization application) is a "database" or that the "large images" are "database objects." Moreover, the Examiner is required to interpret the terms "database" and "database object" in Assignee's claims with their plain meaning, with the broadest reasonable interpretation consistent with the specification, and with the broadest reasonable interpretation consistent with the interpretation that those skilled in the art would reach. *See* MPEP 2111. The Examiner's interpretations are unreasonable, and the Examiner fails to show why a person skilled in the art would reasonably interpret Change's client-server application referred to as the "active visualization application" at page 12 ¶ 5 executing on a server to be consistent with Assignee's "database", and Chang's "large images" at page 12 ¶ 5 to be consistent with Assignee's "database objects."

In fact, there is no discussion in Chang of a database or database objects (or any equivalent entity). Likewise, there is no discussion in Chang of management criteria associated with a database, statistics collected relating to operation of a database, database object characteristics determined from such collected statistics, actions determined and performed on database objects to modify them, monitored results from modifying the database objects, nor reconfiguration of management criteria based on monitored results. Chang is utterly silent about a database and database objects and makes no suggestion that a server is equivalent to a database, that server resource

modules are equivalent to database objects, nor that Chang's framework for tuning the execution of a distributed application is even applicable to a database and database objects.

Even with the fundamental and numerous differences between Chang and Assignee's claims, the Examiner attempts to render the claims obvious by citing to Blattmann as being combinable with Chang. In the rejection, the Examiner simply cites to the Abstract and col. 5, lines 42-45 of Blattmann as providing all of the needed teachings missing from Chang to render Assignee's invention obvious. However, Blattmann does not provide any of the limitations missing from Chang and does not make Chang's teachings applicable to Assignee's claims. Blattmann discusses dynamically configuring a relational database by controlling the configuration of distributed databases based on what processes read from and write to attributes and at what frequency and where the processes are located. *See* Blattmann at Abstract & col. 3, ll. 20-29. To do this, Blattmann discusses using weighting and distribution functions to optimize the configuration and distribution of the distributed database for short processing times, low data transmission, and management costs. *See* Blattmann at col. 5, ll. 20-37 & col. 7, ll. 26-50. These functions can adapt to the changing background conditions and the dynamic reconfiguration of a database system. *Id.*

Even though Blattmann discusses configuring a distributed database, Blattmann fails to teach or suggest the claimed elements missing from Chang. In particular, Blattmann fails to teach or suggest management criteria associated with a database, statistics collected relating to operation of a database, database object characteristics determined from such collected statistics, actions determined and performed on database objects to modify them, monitored results of modifying the database objects, and the management criteria being reconfigured based on the monitored results, as called for in Assignee's claims.

Even if it were appropriate to combine Chang and Blattmann (which Assignee does not concede), Chang in view of Blattmann fails to teach or suggest each and every claimed element of Assignee's claims as discussed above. For at least these reasons,

Chang in view of Blattmann fails to render the claims obvious, and Assignee respectfully requests allowance of all claims in the next paper from the Office.

Fees

No fees are believed due at this time. The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application. Should any fees be due for any reason, the undersigned representative authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 501922, referencing order no. 149-0046US.

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To facilitate the resolution of any issues or questions presented by this paper, Assignee respectfully requests that the Examiner directly contact the undersigned by phone to further the discussion, reconsideration, and allowance of the claims.

Respectfully submitted,

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